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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,661	09/08/2003	Hiroshi Kashiwagi	KON-1821	2782

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EXAMINER
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CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,661

Applicant(s)

KASHIWAGI ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukui et al (US 2002/0102502).

See Fukui et al column 38, claim 1, 11; pages 23, Example 1, [241] to [0273] to pages 24, 26 ; Table 1, samples 7-9, 14-16 which discloses a photothermographic material containing silver halide, silver salt of an aliphatic carboxylic acid, reducing agent and the compound of formula (1) of the present claimed invention. See also the silver halide grains having grain size of 0.01 to 0.15 micron in [0099], doped with hexacyanometal complex in amount of  $10^{-5}$  to  $10^{-2}$  mole per mole of silver halide including metal complexes of iridium, rhodium and iridium in [0101] to [0112]; the preferable long-chain aliphatic carboxylic acid having grain size of 0.01 to 0.23 in [0086] to [0091]; the preferable silver bromide and silver iodobromide in [0097]. Fukui discloses a photothermographic material having composition as claimed, and therefore, the invention as claimed lacks novelty. The property such as SB/SA is the characteristic of the material after development, and this characteristic would be inherent to the material of Fukui because of the same composition thereof.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 16 of U.S. Patent No. US Patent No. 6,808,872. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of organic silver salt grains encompasses light-insensitive silver salt of an aliphatic carboxylic acid claimed in the present claimed invention.

#### ***Response to Arguments***

5. Applicant's arguments filed February 18, 2005 have been fully considered but they are not persuasive for the reason set forth in the rejections above. The applicants argue that the novel aspect of the present invention, the photothermographic material contain a bisphenol compound of formula (1) as an image tone control agent and has sensitivity  $S_B/S_A \leq 0.2$ . The photothermographic material exhibit superior storage stability and silver image lasting quality, as well as enhanced sensitivity and minimized fogging. The material of taught in the applied prior art of record such as Fukui and Kudo do not inherently has property  $S_B/S_A \leq 0.2$  such as shown in the Declaration of Mr. Kashiwagi on February 18, 2005.

The argument is not persuasive. In the claimed invention, SA is defined as "sensitivity obtained when photothermographic material is subjected to imagewise exposure and thermal

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development, and  $S_B$  as a sensitivity obtained when subjected to a heat treatment at  $110^\circ\text{C}$  for 15 second., then, exposed and thermally developed". On page 94, last line to page 95, line 9, the determination of sensitivity ratio ( $S_A/S_B$ ) " each sample was subjected a heat treatment at  $110^\circ\text{C}$  for 15 sec., exposed to white light (4874K) for 30 sec. through an optical wedge, and then developed at  $110^\circ\text{C}$  for a period of 15 sec. The sensitivity of the thus processed sample was determined (designated  $S_B$ ). The sensitivity (designated  $S_A$ ) was determined similarly to the foregoing  $S_B$ , provided that the heat treatment prior to exposure was removed. The sensitivity ratio, ( $S_B/S_A$ ) for each sample was thus determined.". The sensitivities  $S_A$  and  $S_B$  are determined based on the use of white light (4847K) for 30 second and at temperature at development temperature at  $110^\circ\text{C}$  for a period of 15 sec, while the criteria set forth in the claimed invention, both the sensitivity  $S_A$  is obtained by the use of any type of light of any wavelength and at any development temperature, and the sensitivity  $S_B$  is obtained by the use of white light (4847K) for 30 second and at temperature at development temperature at  $110^\circ\text{C}$  for a period of 15 sec. Therefore, the criteria used in the Declaration is not commensurate with the scope of the criteria claimed in the present claimed invention which encompasses image forming process disclosed in Fukui et al on page 25, [0266] to [0272]. The Declaration has a little probative value. There is no different in composition of the claimed material and that disclosed in Fukui et al. The characteristic curve of abscissa-exposure and ordinate-density designates as  $S_B/S_A$  defined in the specification on pages 94-95 is relative to the type of imagewise exposure such as type of light and heating temperature. Same material would produce different  $S_B$  and  $S_A$  depending of the processing method. It is not clearly differentiate the characteristic of the claimed and that of the prior art. Accordingly, the claimed material is anticipated by Fukui et al.

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Moreover, "product of identical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if prior art teaches the identical chemical structure, the properties applicants disclosed and/or claims are necessarily present. *In re Spada*, 91 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)."

The argument with respect to the unexpected results is not persuasive. "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

The argument with respect to the double patenting rejection is not persuasive for the reasons provided in the paragraph 8 above. The claimed invention wholly encompasses the scope of the claimed invention, and no Terminal Disclaimer submitted to obviate the rejection.

The rejection under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kudo (US Patent No. 6,808,872) is withdrawn in view of the statement of common ownership stated provided in the response.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *tchea*  
May 5, 2005

*Thorl Chea*  
Thorl Chea  
Primary Examiner  
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